REMARKS

The Final Office Action, mailed January 10, 2006, considered and rejected claims 2, 7, 9, 11, 16, 18, 21 and 23-29.[1]

By this paper, claims 7, 9 and 26 have been amended and claim 29 has been cancelled, such that claims 2, 7, 9, 11, 16, 18, 21 and 23-28 remain pending, of which claims 11 and 26 are the only independent claims at issue.[2]

Initially Applicants respectfully submit that the amendments to claims 7, 9 and 26 remedy all of the § 112 rejections and objections to the claims. In particular, the claim dependency of claim 9 has been fixed, and appropriate amendments have been made to provide the necessary antecedent basis for the recited claim elements in claims 7 and 26.

As previously discussed, the present invention is generally directed to embodiments for overlaying content over a displayable form of a document in response to a detected event. In some embodiments, for example, this can include overlaying content over a browser displayed document in response to cursor movements to particular regions of a screen.

In claim 26, for instance, the recited method includes retrieving a document from a server and displaying the document. The client system also detects a script tag in the document to a

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[1] Claim 9 was objected to because of informalities. Claims 2, 7, 9, 11, 16, 18, 21 and 23-29 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 26, 2, 11, 18, 25 and 28-29 were rejected under 35 U.S.C. 103(a) as unpatentable over Gao et al (U.S. Publication No. 2002/0032701) in view of Petterson (U.S. Patent No. 6,826,594), Li et al (U.S. Patent No. 6,854,018), Melchner (U.S. Publication No. 2002/0154163), JS-Examples-354, "Open New Windows" and Yehuda Shiran "Scriplet Authoring". Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Gao in view of Pettersen, Li, Melchner, JS-Examples-354, and Shiran as applied to claim 26 above and further in view of Holbrook et al (U.S. Publication No. 2002/0152222). Claims 24 and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gao in view of Pettersen, Li, Melchner, JS-Examples-354, and Shiran as applied to claim 26 above and further in view of JS-Examples-503. Claims 9, 16, 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gao in view of Pettersen, Li, Melchner, JS-Examples-354, and Shiran as applied to claims 1 and 8 above and further in view of Hunt et al (U.S. Publication No. 2004/0133848). Claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over Gao in view of Pettersen, Li, Melchnger, JS-Examples-354, and Shiran as applied to claim 1 above and further in view of McCann et al (U.S. Patent No. 5,963,939).

[2] Support for the claim amendments is found in at least paragraph [0056].

script that is not included in the document. This script tag identifes a URL source of a remote script and includes a single querystring parameter that identifies the displayed document in which the tag is embedded. Thereafter, the client submits a request to the server for the script using the URL and the querystring parameter. In this regard, the querystring parameter ensures that the requested script will be specific to the document identified by the querystring parameter. The identified script is then retrieved, as is relevant event-based content, through use of the querystring parameter that identifies the document. It will be noted that the event-based content is retrieved prior to the client executing the script. Then, only after first obtaining the relevant event-based content, the script is executed to generate a scriptlet that is instrumental in overlaying the obtained content over the displayed document in a new window, such as, for example, in response to detecting an event comprising movement of a cursor within certain boundaries to a specific region of the screen. The method recited in claim 26 also requires the script and event-based content are retrieved from the server at the same time.

Claim 11, which is the only other independent claim at issue, is directed to a corresponding computer program product having computer-executable instructions for implementing the method recited in claim 26.

In rejecting the claims, the Office Action relied on a combination of five different references. The primary reference, Gao, which was used in rejecting all of the claims, teaches a method and system wherein a script referenced in a first webpage is executed to create a second "phantom" webpage, which is hidden until a certain event occurs (such as a cursor movement), at which time it is displayed. In particular, Gao teaches that after requesting a first webpage (element 1 of Figure 5), the webpage is returned with a reference to a script (element 2, Fig. 5; ¶ 47, ll. 6-8; ¶ 48, ll. 1-3 and 10-12). The client then generates a request to the server for the script

(element 3, Fig. 5; ¶ 48, ll. 12-15). In response, the server sends the script back to the client, which is converted into code and which is embedded in the webpage with the other content (element 4, Fig. 5; ¶ 48, ll. 16-22). Next, the client automatically executes the code of the script when it is encountered, thereby requesting that a new webpage be created (element 5, Fig. 5; ¶ 49, ll. 1-5, 14-17). It is only then that the data is obtained for the new webpage, which is sent to the client for display (element 6, Fig. 5; ¶ 49, ll. 14-17). However, as mentioned, the second webpage is hidden until an appropriate time. (element 7, Fig. 5; ¶ 33, ll. 16-22; ¶ 49, ll. 8-13; and ¶ 50).

Notably, Gao teaches that the server does not obtain the event-related content until after the script or code is executed (as part of element 5)(¶ 49, ll. 1-5, 14-17). This is in direct contrast with the claimed invention, wherein the event-based content is retrieved prior to the client executing the script that was referenced by the script tag, as recited in the independent claims.

To compensate for the failings of Gao, in regard to the foregoing, reference is made to Li with further reference to Melchner. Li is generally directed to embodiments in which the histories of fetched objects are used to determine likely associations between fetched html pages and the objects that are likely embedded within them. (Col. 10, ln. 61 thru Col. 11, ln. 9). In particular, "Because object fetches that closely follow a page fetch by the same user are likely co-located, in preferred embodiments the proxy server creates an association between the page and object fetches." Col. 11, ll. 6-9. Li also discloses that associations between the corresponding objects and pages are then stored, such that when pages are subsequently fetched, the server will also examine the correspondingly stored associations and move the associated

objects into cache and such that the objects can be sent to the user directly from the cache without the need for additional fetches. (Col. 11, ll. 19-34).

It will be noted, however, that Li actually fails to remedy the inadequacies of Gao. In particular, Li also fails to disclose or suggest that 'relevant event-based content is retrieved, from the server, prior to executing the script. In particular, Li requires that the scripts are executed at some point prior to downloading or fetching the content. This is necessarily true inasmuch as Li teaches that the identification of which objects to fetch is based on associations established through the analysis of the fetch histories. (see the description above). In other words, if the fetching scripts were never executed in Li, which they must be in order to access the embedded objects, there would be no history to analyze to identify the associations to be stored. Accordingly, Li's script must be executed at some point prior to. downloading or fetching the content, which is contrary to the claimed embodiments. Li's embodiments are also in contrast with the asserted teaching of Melchner corresponding to the claimed element that the script is only executed after first obtaining the relevant event-based content.

Accordingly, it should be appreciated that even if Melchner did disclose that a script is only executed after first obtaining the relevant event-based content, this is inconsistent with at least the teachings of Li. In particular, as stated above, Li requires that the scripts are executed at some point prior to fetching the content inasmuch as the identification of objects to cache is based on associations established through previous fetch histories. Accordingly, inasmuch as Li's script must be executed at some point prior to downloading or fetching the content, it teaches away from the claimed embodiments and the purported disclosure of Melchner.

The incompatibility between some of the cited art is not surprising, however, particularly considering the high number of references that are being combined. In fact, with regard to the

large number of references being combined, Applicants respectfully submit that one of ordinary skill in the art would not find it obvious to modify Gao to incorporate all of the various disclosures.

Applicants also submit that the cited art fails to disclose or suggest that the script and the event-based content are retrieved from the server at the same time. This claim element, which is now incorporated into all of the claims, was previously presented in claim 29. Claim 29 is now cancelled. The last action generally stated that claim 29 was rejected in view of Gao in view of Pettersen in view of Li in view of JS-Examples-354, in view of Shiran. However, there does not appear to be any specific mention to any particular disclosure in any of the foregoing references that teaches or suggests that the script and the event-based content are retrieved from the server at the same time, as previously presented in claim 29 and as now incorporated into all of the claims.

For at least the foregoing reasons, Applicants respectfully submit that all of the rejections of record are now moot and that the pending claims are now in condition for prompt allowance. It will be appreciated that although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last office action, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicant acquiescing to said assertions or rejections.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 9 day of May, 2006.

Respectfully submitted,

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